

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

UPASANI *et al.*

Appl. No. 09/321,882

Filed: May 28, 1999

For: **Neuroactive Steroids of the
Androstane and Pregnane Series**



Art Unit: 1614

Examiner: To be assigned

Atty. Docket: 1483.0130002/RWE/JMC *#4 HKD 9-10-99*

Information Disclosure Statement

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. Copies of each of the documents were previously cited or submitted in Applicants' 35 U.S.C. § 120 priority Application No. 8/659,192, filed June 6, 1996, except for document AG2, a copy of which is enclosed.

The Examiner's attention is directed to the following co-pending U.S. Patent Applications:

U.S. Application No. 08/346,926, filed November 23, 1994 and

U.S. Application No. 09/349,902, filed July 8, 1999.

The identification of these U.S. Patent Applications is not to be construed as a waiver of secrecy to those applications now or upon issuance of the present applications as patents. The Examiner is respectfully requested to consider the cited applications and the art cited therein during examination.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the

effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 are based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Reference AL1, German Patent Document DE 1 050 765, discloses the compound 3α -hydroxypregnan-11-one (3α -hydroxy-etiocholane-11-one) and esters thereof. The reference discloses that the compounds have important physiological and pharmacokinetic properties. Reference AM1 appears to be an English language equivalent.

Reference AN1, French Patent Document FR 1849M discloses the compound 3α -hydroxypregnan-11-one (3α -hydroxy-etiocholane-11-one). The reference further discloses that this compound possesses central nervous system depressing properties and can be employed to combat manifestations of strychnine poisoning. Document AT15 is provided as an English language abstract.

Reference AO1, French Patent Document FR 1,437,361, discloses a process for preparing 17β -alkene ethers or 17β -cycloalkene ethers of steroids of the androstane series, including androstanes having a 3α -hydroxy moiety. The 17β ether groups have the structure depicted by formulas I and II, at page 1, column 1 of the document. Document AR16 is provided as an English language abstract.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.


This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith. It is further understood that the Examiner will consider information that was cited or submitted to the U.S. Patent and Trademark Office in a prior application relied on under 35 U.S.C. § 120. 1138 OG 37, 38 (May 19, 1992).

This Information Disclosure Statement is being filed within three months of the U.S. filing date. No statement or fee is required.

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449 and indicate in the official file wrapper of this patent application that the documents have been considered. The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.


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Date: Sept 8, 1999

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Re: U.S. Non-Provisional Utility Patent Application
Appl. No. 09/321,882; Filed: May 28, 1999
For: **Neuroactive Steroids of the Androstane and Pregnane Series**
Inventors: Upasani *et al.*
Our Ref: 1483.0130002/JMC/BEC

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Information Disclosure Statement (in duplicate);
2. Form PTO-1449 (16 sheets); and
3. Return postcard.

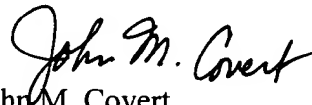
It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Assistant Commissioner for Patents
September 8, 1999
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036. A duplicate copy of this letter is enclosed.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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JMC/BEC/lam

Enclosures